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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/082,309 05/20/98 WALDER

A 15258-176-1U

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TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO CA 94111-3834

EXAMINER

STAIKOVICI, S

ART UNIT

PAPER NUMBER

1732  
DATE MAILED:

*15*  
07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Advisory Action

Application No.  
09/082,309

Applicant(s)  
Andreas Walder

Examiner  
Stefan Stalcovici, Ph.D.

Art Unit  
1732



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED Jun 18, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires six months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Jun 18, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ Request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: None  
Claim(s) objected to: None  
Claim(s) rejected: 16-26, 28, and 29
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: See attachment.

Art Unit: 1732

## **ATTACHMENT TO ADVISORY ACTION**

### ***Amendment***

1. Applicants' After-Final request for reconsideration filed June 18, 2001 (Paper No.13) has been entered. Claims 16-26, 28 and 29 are pending in the instant application.

### ***Response to Remarks***

1. Applicants' arguments filed June 18, 2001 (Paper No.13) have been fully considered.

Applicants argue that "the stages of dis[b]persion and retention are carried out in a single apparatus" because "the two mixers are contained in a common unit 1, 2, where they are situated immediately next to each" and "Figure 4...shows a single block for the unit 1, 2." However, as shown throughout prosecution of the instant application, on page 6, line 21 through page 7, line 6, the original disclosure describes that the step of impregnation, which includes a step of dispersion and a separate step of retention, are performed in a first static mixer (1') and respectively a second static mixer (2'). Further, although in Figure 4 both first (1') and second (2') static mixers are shown together, such an argument is not persuasive, because Applicant has used different reference numbers and also because static mixers (1') and (2') are described (page 6, line 21 through page 7, line 6) and shown as separate units.

Applicants argue that "the term mixer means, in this context, a static structure that is contained in a vessel or a container" and that the "two mixers are arranged in a common container

Art Unit: 1732

that defines the single apparatus” such that when “the medium flows from the first to the second mixer or mixing structure without being forced to pass through a connecting tube a segregation of the blowing agent does not occur.” However, such ~~are~~ arguments are not persuasive because the idea that the “medium flows...*without being forced to pass through a connecting tube*” is not recited in the rejected claim(s) and although, the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, as it was shown in the Final rejection mailed December 19, 2000 (Paper No. 12), Buckner ('377) teaches that since the volatile fluid foaming (blowing) agent may be added within the interfacial surface generator (32) (see col. 4, lines 67-70). Therefore, since a static mixer inherently has a retention time, then it is submitted that the dispensing of the blowing agent and the retaining of the mixture is carried out in a single apparatus, specifically interfacial surface generator (32).

Applicants' arguments regarding the opinion by the EPO-Examiner are not persuasive, because a decision by the European Patent Office is not binding for the US Patent and Trademark Office.

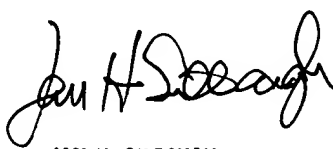
Art Unit: 1732

***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:0 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached at (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1732  
07/06/01

July 5, 2001



Stefan Staicovici, PhD